



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Dean L. Engelhardt et al.

Serial No. Not Yet Known

Filed: February 3, 1998

Title: **NOVEL PROCESS, CONSTRUCT AND
CONJUGATE FOR PRODUCING MULTIPLE
NUCLEIC ACID COPIES**

Group Art Unit: Not Yet Known

Examiner: Not Yet Known

Prev. Examiner: Dianne Rees

Prev. Art Unit: 1807

527 Madison Avenue, 9th Floor
New York, New York 10022
April 16, 1999

FILED BY EXPRESS MAIL

Assistant Commissioner for Patents
United States Patent and Trademark Office
Office of Petitions
Crystal Park One, Suite 520
Washington, D.C. 20231

Attention: **BOX DAC**

**DECLARATION OF LISA CURTIN IN SUPPORT OF
APPLICANTS' PETITION TO OBTAIN A FILING RECEIPT
AND APPLICATION SERIAL NUMBER UNDER 37 C.F.R. §1.53**

Dear Sirs:

I, Lisa Curtin, declare as follows:

1. I am a paralegal employed by Enzo Biochem, Inc. ("Enzo"), the parent company to the assignee of the above-identified patent application. I have been employed by Enzo since 1994, during which time I have worked under the direction of Enzo's Corporation and Patent Counsel, Ronald C. Fedus.

2. In the course of my employment, I have assisted Mr. Fedus in the prosecution of Enzo's patent applications, including the subject application. I have personal knowledge of the facts and circumstances set forth below.

3. I am making this Declaration in support of Applicants' Petition To Obtain a Filing Receipt and Application Serial Number for this application.

Enz-52(C)

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And Application Serial Number Under 37 C.F.R. §1.53 - April 16, 1999)

4. The subject continuation application was filed on February 3, 1998, together with two other divisional applications, and a petition to revive the parent application (Serial No. 08/182,621, filed January 13, 1994), the latter now abandoned. A copy of the February 3, 1998 Petition to Revive and the subject continuation application filed therewith are attached hereto as Exhibit A.

5. All three applications (one continuation and two divisional applications) and the revival petition were mailed to the Patent Office in one large Express Mail box to which was affixed Express Mail Label No. EM36656657. A copy of Express Mail Label No. EM36656657 is attached as Exhibit B. A receipt of Express Mail Label No. EM36656657 indicating delivery to the Patent Office on February 3, 1998 was subsequently returned to the Assignee (copy attached as Exhibit C). Four original self-addressed, stamped return post cards submitted with the three applications and the revival petition were subsequently returned to the Assignee. The postcards have been stamped by the Patent and Trademark Office Mailroom indicating receipt of the filings on February 3, 1998. Copies of the four date-stamped post cards are attached as Exhibit D. None of the postcards attached to the continuation application or the two divisional applications bear any indication that serial numbers were assigned to the applications, the space for the serial number having been left blank.

6. On February 18, 1998, I telephoned the Application Branch of the Patent and Trademark Office and spoke to Ms. Jay concerning the missing serial numbers on the three PTO date-stamped return post cards for the three patent applications. In accordance with Ms. Jay's request, our conversation was memorialized in a telefax sent to Ms. Jay by me on that same day. A copy of my February 18, 1998 telefax to Ms. Jay is attached as Exhibit E.

7. On April 20, 1998, Applicants' attorney received a decision dated April 15, 1998 on the revival petition for the parent application, a copy of which is attached as Exhibit F. This decision revived the parent application for purposes of continuity, which application was again abandoned "in favor of the continuing applications stated to have been filed concurrently herewith."

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8. On April 20, 1998, I wrote to Enzo's associates, Cantwell & Paxton, in Arlington, Virginia, requesting that they pursue the matter of requesting the three serial numbers in person with the Patent Office. A copy of my April 20, 1998 letter to Cantwell & Paxton request is attached as Exhibit G. To date, Cantwell & Paxton have been unsuccessful in obtaining the three serial numbers.

9. On April 14, 1999, I telephoned the Patent Office Help Line and inquired as to the best way to go about obtaining serial numbers and filing receipts for the three application in question. The Help Line representative was unable to provide a solution or a course of action. I then attempted to contact by telephone the Examiner who was handling the parent application, and was informed that she was no longer with the Patent Office.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that any such willful false statements may jeopardize the validity of the application or any patent issued thereon.

April 16 1999
Date

Lisa Curtin
Lisa Curtin

* * * * *

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): Dean L. Engelhardt et al.
 Serial No.: 08/182,621 Group Art Unit: Not Yet Known
 Filed: January 13, 1994 Examiner: Not Yet Known
 For: NOVEL PROCESS, CONSTRUCT AND CONJUGATE
 FOR PRODUCING MULTIPLE NUCLEIC ACID COPIES

**VERIFIED STATEMENT (DECLARATION) CLAIMING SMALL ENTITY
 STATUS (37 CFR 1.9 (f) and 1.27 (c)) - SMALL BUSINESS CONCERN**

I hereby declare that I am

- ☐ the owner of the small business concern identified below:
☒ an official of the small business concern empowered to act on behalf of the concern identified below:

NAME OF CONCERN ENZO DIAGNOSTICS, INC.

ADDRESS OF CONCERN c/o ENZO BIOCHEM, INC.
575 FIFTH AVENUE (18TH FLOOR)
NEW YORK, NEW YORK 10017

I hereby declare that the above identified small business concern qualifies as a small business concern as defined in 13 CFR 121.3-18, and reproduced in 37 CFR 1.9(d), for purposes of paying reduced fees under section 41(a) and (b) of Rule 35, United States Code, in that the number of employees of the concern, including those of its affiliates does not exceed 500 persons. For purposes of this statement, (1) the number of employees of the business concern is the average over the previous fiscal year of the concern of the persons employed on a full-time, part-time or temporary basis during each of the pay periods of the fiscal year, and (2) concerns are affiliates of each other when either, directly or indirectly, one concern controls or has power to control the other, or a third party or parties controls or has the power to control both.

I hereby declare that rights under contract or law have been conveyed to and remain with the small business concern identified above with regard to the invention entitled:

**NOVEL PROCESS, CONSTRUCT AND CONJUGATE
 FOR PRODUCING MULTIPLE NUCLEIC ACID COPIES**

by inventor(s)

Dean L. Engelhardt et al.

described in

- ☐ the specification filed herewith
☒ Application Serial No. 08/182,621, filed January 13, 1994

☐ Patent No. _____, issued _____

If the rights held by the above identified small business concern are not exclusive, each individual, concern or organization having rights to the invention is listed below* and no rights to the invention are held by any person other than the inventor, who could not qualify as a small business concern under 37 CFR 1.9(d) or by any concern which would not qualify as a small business concern under 37 CFR 1.9(d) or a nonprofit organization under 37 CFR 1.9(e).

*NOTE: Separate verified statements are required from each named person, concern or organization having rights to the invention averring to their status as small entities. (37 CFR 1.27).

NAME _____

ADDRESS _____
☐ Individual ☐ Small Business Concern ☐ Nonprofit

I acknowledge the duty to file, in this application or patent, notification of any change in status resulting in loss of entitlement to small entity status prior to paying, or at the time of paying, the earliest of the issue fee or any maintenance fee due after the date on which status as a small business entity is no longer appropriate. (37 CFR 1.28(b)).

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statement may jeopardize the validity of the application, any patent issuing thereon, or any patent to which this verified statement is directed.

NAME OF PERSON SIGNING BARRY W. WEINER
 TITLE OF PERSON OTHER THAN OWNER EXECUTIVE VICE PRESIDENT
 ADDRESS OF PERSON SIGNING 575 FIFTH AVENUE (18TH FLOOR)
NEW YORK, NEW YORK 10017

SIGNATURE [Signature] DATE JUNE 14, 1994

DECLARATION FOR PATENT APPLICATION

Docket No. **ENZ-52**

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

**NOVEL PROCESS, CONSTRUCT AND CONJUGATE
FOR PRODUCING MULTIPLE NUCLEIC ACID COPIES**

the specification of which

(check one) ☐ is attached hereto.

☒ was filed on January 13, 1994, as Application Serial No. **08/182,621**
and was amended on _____, 1994 (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose information which is material to the examination of this application in accordance with Title 37, Code of Federal Regulations, §1.56(a).

I hereby claim foreign priority benefits under Title 35, United States Code, §119 of any foreign application(s) for patent or inventor's certificate listed below and have also identified below any foreign application for patent or inventor's certificate having a filing date before that of the application on which priority is claimed:

Prior Foreign Application(s)

Priority Claimed

(Number)	(Country)	(Day/Month/Year Filed)	Yes	No
(Number)	(Country)	(Day/Month/Year Filed)	Yes	No

I hereby claim the benefit under Title 35, United States Code, §120 of any United States application(s) listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of Title 35, United States Code, §112, I acknowledge the duty to disclose material information as defined in Title 37, Code of Federal Regulations, §156(a) which occurred between the filing date of the prior application and the national or PCT international filing date of the application:

(Application Serial No.)	(Filing Date)	(Status-patented, pending, abandoned)
(Application Serial No.)	(Filing Date)	(Status-patented, pending, abandoned)

I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

Ronald C. Fedus, Esq., Reg. No. 32,567.

Address all telephone calls to: Ronald C. Fedus, Esq., at telephone no. (212)-856-0876
Address all correspondence to: Ronald C. Fedus, Esq., Corporation & Patent Counsel
Enzo Biochem, Inc.
575 Fifth Avenue - 18th Floor
New York, NY 10017

Dean L. Engelhardt
Jannis G. Stavrianopoulos et al.
Serial No. 08/182,621
Filed: January 13, 1994
Page 2 (Declaration For Patent Application)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

second joint
Full name of ~~sole or first~~ inventor Jannis G. Stavrianopoulos
First Inventor's signature _____ Date _____
Residence 99 South Clinton Avenue (No. 11D), Bay Shore, New York 11706 Citizenship United States
Post Office Address (Same as above)

first joint
Full name of second joint inventor, if any Dean L. Engelhardt
Second Inventor's signature Dean L. Engelhardt Date _____
Residence 173 Riverside Drive (No. 6D), New York, New York 10025 Citizenship United States
Post Office Address (Same as above)

Full name of third joint inventor, if any Elazar Rabbani
Third Inventor's signature _____ Date _____
Residence 69 Fifth Avenue (No. 19A), New York, New York 10003 Citizenship United States
Post Office Address (Same as above)

Full name of fourth joint inventor, if any James J. Donegan
Fourth Inventor's signature _____ Date _____
Residence 210 East Broadway (No. 3G), Long Beach, New York 11561 Citizenship United States
Post Office Address (Same as above)

* * * * *

Dean L. Engelhardt
Jannis G. Stavrianopoulos et al.
Serial No. 08/182,621
Filed: January 13, 1994
Page 2 (Declaration For Patent Application)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

^{second joint}
Full name of ~~sole or first~~ inventor Jannis G. Stavrianopoulos
First Inventor's signature [Signature] Date 6/18/94
Residence 99 South Clinton Avenue (No. 11D), Bay Shore, New York 11706 Citizenship United States
Post Office Address (Same as above)

^{first}
Full name of ~~second~~ joint inventor, if any Dean L. Engelhardt
Second Inventor's signature _____ Date _____
Residence 173 Riverside Drive (No. 6D) New York, New York 10025 Citizenship United States
Post Office Address (Same as above)

Full name of third joint inventor, if any Elazar Rabbani
Third Inventor's signature _____ Date _____
Residence 69 Fifth Avenue (No. 19A) New York, New York 10003 Citizenship United States
Post Office Address (Same as above)

Full name of fourth joint inventor, if any James J. Donegan
Fourth Inventor's signature [Signature] Date 6/13/94
Residence 210 East Broadway (No. 3GT) Long Beach, New York 11561 Citizenship United States
Post Office Address (Same as above)

* * * * *

Dean L. Engelhardt
Jannis G. Stavrianopoulos et al.
Serial No. 08/182,621
Filed: January 13, 1994
Page 2 (Declaration For Patent Application)

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^{second joint}
Full name of sole or first inventor Jannis G. Stavrianopoulos
First Inventor's signature _____ Date _____
Residence 99 South Clinton Avenue (No. 11D) Bay Shore, New York 11706 Citizenship United States
Post Office Address (Same as above)

^{first}
Full name of second joint inventor, if any Dean L. Engelhardt
Second Inventor's signature _____ Date _____
Residence 173 Riverside Drive (No. 6D) New York, New York 10025 Citizenship United States
Post Office Address (Same as above)

Full name of third joint inventor, if any Elazar Rabbani
Third Inventor's signature [Signature] Date 1/13/94
Residence 69 Fifth Avenue (No. 19A) New York, New York 10003 Citizenship United States
Post Office Address (Same as above)

Full name of fourth joint inventor, if any James J. Donegan
Fourth Inventor's signature _____ Date _____
Residence 210 East Broadway (No. 3G) Long Beach, New York 11561 Citizenship United States
Post Office Address (Same as above)

* * * * *

Docket No.: ENZ-52

ASSIGNMENT

In consideration of One Dollar (\$1.00), and other good and valuable consideration, the receipt of which is hereby acknowledged, I, the undersigned,

Dean L. Engelhardt,
Jannis G. Stavrianopoulos,
Elazar Rabbani, and
James J. Donegan,

RESIDING AT:

173 Riverside Drive (No. 6D), New York, New York 10025;
99 South Clinton Avenue (No. 11D), Bay Shore, New York 11706;
69 Fifth Avenue (No. 19A), New York, New York 10003; and
210 East Broadway (No. 3G), Long Beach, New York 11561; respectively

Hereby sell, assign and transfer to: Enzo Diagnostics, Inc., a corporation of the State of New York, having a principal place of business at: 60 Executive Boulevard, Farmingdale, New York 11735-4716, its successors, assigns and legal representatives, the entire right, title and interest for the United States and all foreign countries, in and to any and all improvements which are disclosed in the application for United States Letters Patent, which has been executed by the undersigned concurrently herewith, and is entitled:

NOVEL PROCESS, CONSTRUCT AND CONJUGATE FOR PRODUCING MULTIPLE NUCLEIC ACID COPIES


(said application having been filed on January 13, 1994 and accorded U.S. Patent Application Serial No. 08/182,621)

and in and to said application and all divisional, continuing, substitute, renewal, reissue, and all other applications for Letters Patent which have been or shall be filed in the United States and all foreign countries on any of said improvements; and in and to all original and reissued patents which have been or shall be issued in the United States and all foreign countries on said improvements:

Agree that said Assignee may apply for and receive Letters Patent for said improvements in its own name, and that, when requested, without charge to but at the expense of said Assignee, its successors, assigns and legal representatives, to carry out in good faith the intent and purpose of this assignment, the undersigned will execute all divisional, continuing, substitute, renewal, reissue, and all other patent applications on any and all said improvements; execute all rightful oaths, assignments powers of attorney and other papers, communicate to said Assignee, its successors, assigns, and representatives, all facts known to the undersigned relating to said improvements and the history thereof; and generally do everything possible which said Assignee, its successors, assigns or representatives shall consider desirable for aiding in securing and maintaining proper patent protection for said improvements and for vesting title to said improvements and all applications for patents and all patents on said improvements, in said Assignee, its successors, assigns and legal representatives; and

Dean L. Engelhardt
~~Jannis G. Stavrianopoulos~~ et al.
Serial No. 08/182,621
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Page 2 (Assignment)

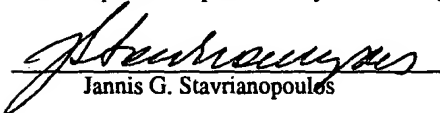
Covenant with said Assignee, its successors, assigns and legal representatives that no assignment, grant, mortgage, license or other agreement affecting the rights and property herein conveyed has been made to others by the undersigned, and that full right to convey the same as herein expressed is possessed by the undersigned.

Jannis G. Stavrianopoulos	(date)
 Dean L. Engelhardt	01/14/94 (date)
Elazar Rabbani	(date)
James J. Donegan	(date)

* * * * *

Dean L. Engelhardt
Jannis G. Stavrianopoulos c. u.
Serial No. 08/182,621
Filed: January 13, 1994
Page 2 (Assignment)

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Jannis G. Stavrianopoulos

6/13/94
(date)

Dean L. Engelhardt

(date)

Elazar Rabbani


(date)


James J. Donegan

6/13/94
(date)

Dean L. Engelhardt
~~Jannis G. Stavrianopoulos~~ e. al.
Serial No. 08/182,621
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Page 2 (Assignment)

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_____ Jannis G. Stavrianopoulos	_____ (date)
_____ Dean L. Engelhardt	_____ (date)
_____  Elazar Rabbani	_____ 6/13/1994 (date)
_____ James J. Donegan	_____ (date)

* * * * *